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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,829	07/17/2003	Volker Klaus Null	TS-9504 (US)	1992
23632	7590	09/23/2005	EXAMINER	
SHELL OIL COMPANY P O BOX 2463 HOUSTON, TX 772522463			LEE, RIP A	
			ART UNIT	PAPER NUMBER
			1713	
DATE MAILED: 09/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,829

Applicant(s)

NULL, VOLKER KLAUS

Examiner

Rip A. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 4, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 and 14 is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action follows a response filed on March 7, 2005. Applicants have amended claims 3, 4, and 13. Claims 3, 4, 13, and 14 remain pending. The indicated allowability of claim 3 has been withdrawn in view of newly discovered references to Heemann *et al.* (U.S. 2003/0105259), Koblitz *et al.* (U.S. 5,360,350), and Makowski *et al.* (U.S. 3,927,143). Rejections based on the newly cited reference follow.

Claim Rejections - 35 USC § 102 / 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claim 3 is rejected under 35 U.S.C. 102(e) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Heemann *et al.* (U.S. 2003/0105259).

Heemann *et al.* discloses a composition comprising styrene copolymer and, as plasticizer, white (mineral) oil (paragraph [0048], [0084], example 1) having a kinematic viscosity of 551 mm²/s at 20 °C. The reference does not disclose the kinematic viscosity at 100 °C, however, a reasonable basis exists to believe the kinematic viscosity is more than recited, minimum value of 7 mm²/s, especially in light of the fact that the kinematic viscosity is two orders of magnitude higher at 20 °C. Since the PTO can not perform experiments, the burden is shifted to the Applicants to establish an unobviousness difference.¹

The recitation "Fischer-Tropsch derived" in the claim is presented in product-by-process form. It is well settled that where product by process claims are rejected over a prior art product that appears to be the same, the burden is shifted to the Applicant to establish an unobviousness difference, even if the production processes are different.^{2,3} Furthermore, the patentability of a product claim rests on the product formed, not on the method by which it was produced.⁴

3. Claim 3 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Koblitz *et al.* (U.S. 5,360,350).

Koblitz *et al.* teaches a composition comprising a thermoplastic copolymer and white (mineral) oil (see claims 1, 2 and 43). Mineral oils of the invention have a relatively high viscosity (SUS of from about 300 to 600 at 100 °F; col. 17, lines 2-5). Example 1 discloses a composition comprising styrenic copolymer and Kaydol oil, the latter having a kinematic viscosity of 65-70 cSt (mm²/s) at 40 °C. The reference does not disclose the kinematic viscosity at 100 °C, however, a reasonable basis exists to believe the kinematic viscosity is more than recited, minimum value of 7 mm²/s, especially in light of the fact that the kinematic viscosity is two orders of magnitude higher at 20 °C. Since the PTO can not perform experiments, the burden is shifted to the Applicants to establish an unobviousness difference.¹

The recitation "Fischer-Tropsch derived" in the claim is presented in product-by-process form. It is well settled that where product by process claims are rejected over a prior art product that appears to be the same, the burden is shifted to the Applicant to establish an unobviousness difference, even if the production processes are different.^{2,3} Furthermore, the patentability of a product claim rests on the product formed, not on the method by which it was produced.⁴

4. Claim 3 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Makowski *et al.* (U.S. 3927,143).

Example 2 of Makowski *et al.* discloses a composition comprising a styrene block copolymer and Primol D white oil having a kinematic viscosity of 240 cSt (mm²/s) at 20 °C. The reference does not disclose the kinematic viscosity at 100 °C, however, a reasonable basis exists to believe the kinematic viscosity is more than recited, minimum value of 7 mm²/s, especially in light of the fact that the kinematic viscosity is two orders of magnitude higher at 20 °C. Since the PTO can not perform experiments, the burden is shifted to the Applicants to establish an unobviousness difference.¹

The recitation "Fischer-Tropsch derived" in the claim is presented in product-by-process form. It is well settled that where product by process claims are rejected over a prior art product that appears to be the same, the burden is shifted to the Applicant to establish an unobviousness

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difference, even if the production processes are different.^{2,3} Furthermore, the patentability of a product claim rests on the product formed, not on the method by which it was produced.⁴

Allowable Subject Matter

5. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As indicated in the previous office action, claims 13 and 14 are allowed.

¹ *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

² *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

³ Since it is the patentability of a product claimed, and not of the recited process steps, which must be established, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable in cases where the prior art discloses a produce which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). See also MPEP § 2113.

⁴ *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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September 15, 2005



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